

REMARKS

By the present Amendment, dependent claims 15 and 16 have been added consistent with the teachings of the specification such as in the paragraph bridging pages 21 and 22 and the passage extending from page 26, line 20 to page 34, line 21, respectively. The previously presented claims have not been amended since applicant respectfully submits that all the claims in the present application are patentable particularly in view of the following discussion and the evidence of record which includes the attached Declaration Under 37 C.F.R. §1.132.

As recited in claim 1, one aspect of the invention relates to a method of making a lithographic printing plate from a heat-sensitive pre-sensitized plate of a positive working mode for lithographic printing. The method comprises the steps of exposing the heat-sensitive pre-sensitized plate to light, and developing the plate using an alkaline developing solution comprising at least one compound having three or more ethylene oxide-terminal groups in the molecule thereof, wherein the pre-sensitized plate comprises a substrate, a lower layer which comprises a water-insoluble and alkali-soluble resin, and an upper heat-sensitive layer which comprises a water-insoluble and alkali-soluble resin and an infrared absorption dye and exhibits an elevated solubility with respect to alkaline aqueous solutions when heated. The lower layer and the upper heat-sensitive layer are located on the substrate in the stated order.

By following the teachings of the present invention, one can obtain effective development of the exposed plate so that non-image areas are sufficiently developed without providing a residue of the lower layer on the non-image areas. Such advantageous results can be seen from the examples set forth in Tables 2 and 3 on pages 77-78, the results of which are reported in Tables 5 and 6 on pages 82-

83 and Tables 8 and 9 on pages 85-86. In this respect, it will be noted that the results are superior to those which can be obtained by using polyethylene glycol having a molecular weight of 1,000 or 1,500 in Comparative Examples 2, 3, 5 and 6. In addition, the specification notes that good durability and sensitivity can be attained.

In the Official Action, the Examiner has raised a single rejection of all of the previously submitted claims under 35 U.S.C. §103(a) based on the combined disclosures of EP 1182512, EP 1211065 and JP 2003-21788.¹ The Examiner has recognized that the cited documents do not individually teach the presently claimed method with the defined heat-sensitive, pre-sensitized plate with the defined upper and lower layers and the defined alkaline developing solution with the at least one compound having three or more ethylene oxide-terminal groups in the molecule, but has asserted in the section bridging pages 3 and 4 of the Action that the combined documents render the invention obvious.

Applicant respectfully disagrees with the Examiner's position. The prior art does not in any way teach the present invention and does not provide the significant advantages of sensitivity and printing durability which the present invention can attain. To illustrate this point, attached hereto is a Declaration Under 37 C.F.R. §1.132 which sets forth experiments which follow the teachings of each of the cited documents and compares them with illustrative embodiments of the present invention. In each situation, the Comparative Examples of the three prior art documents provide inferior results with respect to both printing durability and

¹ The EP '512 was identified in the Information Disclosure Statement filed concurrently with the present application and applicant notes that the Examiner may have inadvertently failed to initial this document on the citation form which accompanied the Action. Therefore, applicant respectfully requests formal acknowledgement of EP '512 in the next Official Action.

sensitivity when compared to the illustrative embodiments of the present invention.


In this regard, applicant is justified in comparing the present invention with the closest prior art which actually exists (i.e., in accordance with the individual documents) rather than subject matter that does not exist, *see, In re Geiger*, 2 USPQ2D 1276 (Fed. Cir. 1987) (cited in MPEP §716.02(d)). Thus, while applicant does not concede that the cited documents can be properly combined to establish a *prima facie* case of obviousness, the evidence of record clearly rebuts any arguable *prima facie* case.

Since the single prior art rejection raised in the Official Action is believed to be fully met by the instant response including the aforementioned Declaration, applicant respectfully requests reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

BUCHANAN INGERSOLL PC

By: 
Robert G. Mukai
Registration No. 28,531

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: December 8, 2005